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AUG 6
CHARLES ELMORE

IN THE

Supreme Court of the United States.

OCTOBER TERM, 1934.

No. 254

PARAMOUNT PUBLIX CORPORATION,

Petitioner,

vs.

AMERICAN TRI-ERGON CORPORATION,

Respondent.

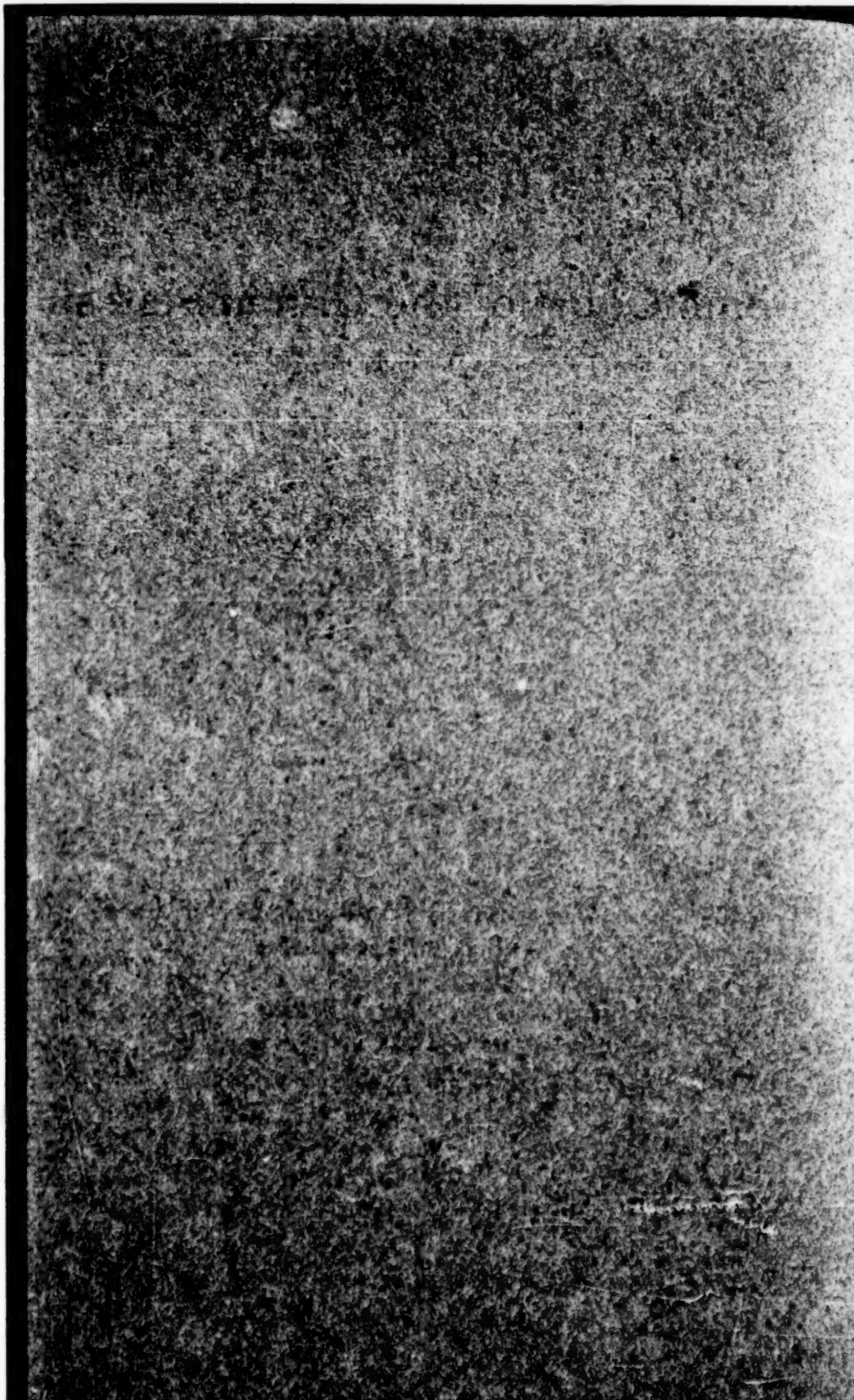
ON PETITION FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

OPINIONS

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The Opinion of the District Court, Reported in 4 F. Supp. 462.

United States District Court,

EASTERN DISTRICT OF NEW YORK.

American Tri-Ergon Corporation, Plaintiff, vs. Paramount Publix Corporation, Defendant.	Equity 5800 August 14, 1933.

Ward, Crosby & Neal, solicitors for plaintiff; S. Mortimer Ward, Jr. and Page S. Haselton, of counsel.

Charles Neave, Henry R. Ashton, W. J. Barnes, F. T. Woodward, and E. J. Driscoll, counsel for defendant.

Campbell, *D. J.*

Plaintiff brings this suit against the defendant for relief by injunction and damages for the alleged infringement by the defendant, at its studio in Long Island City, of patent No. 1,825,598, issued to Vogt, Massolle and Engl, by mesne assignments to the plaintiff, for Process of Producing Combined Sound and Picture Films, granted September 29, 1931, on application filed March 29, 1922, corresponding to German Application No. V. 16431 VI/57 a2, filed April 14, 1921. This has been held by the Patent Office to be the effective date under the International Convention.

No evidence was offered showing any commercial activity of the plaintiff, or of any one operating under license from it.

The defendant is a well known motion picture producer.

This suit is being defended by Electrical Research Products, Inc., the wholly owned subsidiary of the Western Electric Company, formed to take over the commercial distribution of the Western Electric talking motion picture sound recording and reproducing systems which were developed by the research laboratories of the Western Electric and American Telephone & Telegraph Companies.

The defendant is licensed by the Research Products, Inc. to record for talking pictures by means of the Western Electric system, and has from the beginning used that system and apparatus.

The defendant has by answer interposed the defenses of invalidity and noninfringement.

This suit is based on claims 5 to 9, both inclusive, and claim 11 of the patent in suit, but claims 6 and 7 are to be read with the Disclaimer, filed November 23, 1932.

Said claims and disclaimer read as follows:

> "5. A process for producing a combined sound and picture positive film, for talking moving pictures, comprising, photographing a sequence of pictures on one length of film, and simultaneously photographing on another length of film a corresponding sequence of sounds accompanying the action, separately developing the two negatives in a manner appropriate for each, and printing the sound and picture negatives respectively upon different longitudinally extending portions of the same sensitized film, to form the sound sequence at one side of and along the picture sequence.
>
> 6. A process for producing a combined sound and picture positive film, for talking moving pictures, comprising, photographing a sequence of pictures on one length of film, and simultaneously photographing on another length of film a corresponding sequence of sounds accompanying the action, so that the picture and sound negatives may be separately developed in a manner appropriate for each, and printing the

sound and picture negatives respectively upon different longitudinally extending portions of the same sensitized film, to form the sound sequence at one side of and along the picture sequence.

7. A process for producing a combined sound and picture positive film, for talking moving pictures, comprising, photographing a sequence of pictures on one length of film, and simultaneously photographing on another length of film a corresponding sequence of sounds accompanying the action, so that the picture and sound negatives may be separately developed in a manner appropriate for each, and printing the sound and picture negatives respectively upon the same face of the same sensitized film at different longitudinally extending portions thereof, to form the sound sequence at one side of and along the picture sequence.

8. The method of producing a talking moving picture record on a single film which comprises photographing simultaneously upon separate films the picture and the sound to form separate negatives, photographing said negative picture record upon a portion of a sensitized film not exposed to a sound record and photographing the negative sound record on the same face of said last film and at a portion thereof not exposed to the picture record.

9. The method of producing a talking moving picture record on a single film which comprises photographing simultaneously upon separate films the picture and the sound to form separate negatives, photographing said negative picture record upon a portion of a sensitized film not exposed to a sound record, and photographing the negative sound record on the same face of said last film and at a portion thereof not exposed to the picture record, said last two photographing steps being performed consecutively."

"11. A process for producing a combined sound and picture positive film, for talking moving pictures, comprising, photographing a sequence of pictures on one length of film, and simultaneously photographing on another length of film a corresponding sequence of

sounds accompanying the action, separately developing the records of said two lengths of film in a manner appropriate for each, and printing such developed sound and picture records respectively upon different longitudinally extending portions of a single sensitized film, to form the sound sequence at one side of and along the picture sequence."

"DISCLAIMER

To the Hon. Commissioner of Patents:

Your petitioner, American Tri-Ergon Corporation, a corporation organized and existing under the laws of the State of New York and having a place of business in the City, County and State of New York, represents that in the matter of certain improvements in Process for Producing Combined Sound and Picture Films, for which Letters Patent of the United States No. 1,825,598 were granted on September 29, 1931 to said American Tri-Ergon Corporation, as assignee by mesne assignments of the inventors, Hans Vogt, Joseph Massolle and Josef Engl, said corporation is the owner of the entire right, title and interest under an assignment dated June 6, 1930 and recorded in the Transfers of Patents of the United States Patent Office, July 3, 1930, Liber T 144, pages 192 to 199, and other assignments referred to in said assignment, and that your petitioner has reason to believe that through inadvertence and without any fraudulent or deceptive intention, the specification and claim of said Letters Patent are too broad, including that of which said inventors were not the first inventors.

Your petitioner therefore hereby enters this disclaimer to that part of the claim which it does not choose to claim or hold by virtue of the patent or said assignments, to wit:

(a) The process as set forth in claim 6, except wherein the picture and sound negatives are separate films at the time of development.

(b) The process as set forth in claim 7, except wherein the sequence of pictures is photographed upon

a film separate from that upon which the sequence of sounds is photographed, and the picture and sound negatives are separately developed, in a manner appropriate for each, and are consecutively printed upon the same sensitized film."

More than nine years elapsed between the date of the filing of the application in question in the United States Patent Office and the date of the granting of the patent in suit, and the claims in suit were introduced by amendment dated July 15, 1931.

During that long period of time the defendant and the Western Electric, its parent company, engaged extensively in the commercial distribution of said Western Electric talking motion picture sound recording and reproducing systems.

At the time of the application in the United States Patent Office for the patent in suit in 1922, it was common and necessary practice in the motion picture industry to compensate, so far as was possible, for over and under exposure of different scenes or takes of motion pictures by under and over development, respectively, of the picture negatives.

This was accomplished by what was known as the rack and tank development, in which each scene was wound on a rack and then submerged in a tank containing the developer, the development being watched by the operator, who from time to time lifted the rack and film from the tank, and exercising his individual judgment, determined the extent to which the development of the particular scene should be carried.

This, of course, resulted in merely a compromise, inasmuch as no amount of manipulation would make it right, if the exposure was not correct in the first place, but would merely change the degree in which it was not correct.

In recording sound photographically the negative sound record, it was realized, would be uniformly, if not correctly or normally, exposed (a uniform source of light

being used) and, therefore, should receive a uniform development throughout.

To continue the practice of compensating in the developing of the pictures for under and over exposure of the pictures, the patentees wished to develop their picture records separately from their sound records.

This the patentees described in their specifications as originally filed in the United States, in 1922, as follows:

> "In the production of speaking films it is of great advantage especially from the point of view of use, to arrange the sound sequence and the picture sequence upon one and the same material separate (film).
>
> "In this procedure, however, there frequently occur in consequence of the changing lighting conditions in the cinematographing process, changes in the degree of light and the bromide of silver layer, and this causes the picture sequence to be either overlighted or underlighted.
>
> "As the same film, however, bears close to the picture sequence the continuously normally lighted sound sequence, these differences cannot be removed in the case of combined negatives, by developing, weakening, strengthening, and so forth. They can only be removed by subjecting the underlighted or the overlighted negative places to separate corresponding treatment.
>
> "Technically, this treatment is practically impossible so long as the two sequences are photographed upon the same film."

Further such original specification says:

> "According to the present invention the difficulty is overcome by either employing entirely separate films for the production of the negatives, or films which are connected during the photographing, but which are separated from one another before the developing."

The difficulty which the patentees were seeking to overcome was under and over exposure of the different

picture scenes, which they proposed to do by developing the negative picture records separately from the negative sound record.

The alleged invention cannot be considered as broadly, for having the picture and sound records on different films, so that they are separately developed, as that was old and there would be no invention.

The paragraph of the specifications last quoted proposes two ways of obtaining the separate negatives, (1) to record sound and picture films on separate films in the first instance, (2) to separate the two records after recording them on the same film. This is shown on the drawings added by amendment.

Fig. 1 shows sound and picture records recorded on separate films of standard width. Fig. 3 shows two negative records recorded on a wide non-standard film, having three rows of sprocket perforations, and which are severed at either p or u before development. Fig. 2 shows a wide non-standard positive print produced by printing the separate or separated negative records preferably consecutively on the same film.

The specification states that the two negatives of Fig. 1 or the separated negatives of Fig. 3 may be united or pasted together prior to the printing and then copied "in the usual manner".

In the separate film process of Fig. 1, there are three or four steps depending on whether the two records are or are not pasted together before printing, namely, (1) exposing, (2) developing, and (3) printing, and if the two records are pasted together before printing, that constitutes the fourth step.

In the divided film process of Fig. 3, which is claimed in claim 2, there are four or five steps, depending on whether the divided or separated negatives are or are not pasted together or reunited before printing; but this process needs no further consideration as it is not in suit.

The claims in suit may be divided into two groups, namely, (1) claims 8 and 9, which are two-step claims for exposing and printing; (2) claims 5, 6, 7 and 11, which are three-step claims, the additional step being the developing, claims 6 and 7 being read with the disclaimer.

The specification further states:

> "The synchronism is assured in both cases by the perforations and by corresponding marks. The production of the positive films can take place by copying the two negative films preferably consecutively upon the same positive films.
>
> "One can, however, also unite previously, the two negative films longitudinally together, and then copy this so united negative in the usual manner."

Nowhere in their said original specification or claims did the patentees state or even suggest that it was at all material that the two negatives be printed on the same side or face of the positive film.

Plaintiff's expert says that he finds it by inference which he gets from the specification, and prior practice on this point.

I cannot agree with him.

The most that the patentees in the specification say is that it is desirable to "arrange" the two records "upon one and the same material carrier (film)"; that "the production of the positive films can take place by copying the two negative films preferably consecutively upon the same positive films"; and, in original claim 1, that the two records are "copied upon single film".

The idea of recording sound on film, of recording pictures on film, or both sound and pictures on the same film, of recording sound and pictures on separate films so as to be able to develop them separately and then project them together, or of printing sound and pictures from separate negatives upon a single film, were separately

and collectively old prior to the conception date of either party, neither of which goes back of 1921.

See Greensfelder patent No. 1,254,684, which disclosed everything but simultaneously recording; De Forest patent No. 1,446,246.

It is true that Greensfelder recorded his sound record after he took his pictures, instead of doing it at the same time.

There was, however, no novelty in simultaneous recording, as this was old. For example, see Bullis patent No. 1,335,651, and Craig patent No. 1,260,337.

The plaintiff urges that defendant cannot with good grace contest patentability, in view of the application of Wente, a research engineer of the Western Electric Company, to which he assigned such application; but this contention was not sustained. Wente did make broad claims as is customary, but those broad claims were cancelled on the first amendment, and as I believe on Greensfelder rather than on the Vogt British patent. In any event, claims similar to some of the Wente claims so cancelled were made by Craig, in 1913 and cancelled as unpatentable at that time.

The claims of the patent granted to Wente are limited, and I do not see how his application prejudices the defense in this action.

The plaintiff's expert stated on cross-examination that what he thought was new in the patent in suit, and not found in the prior art, was printing both the separately exposed, separately developed negatives side by side, on the same side of the positive film.

On re-direct examination he stated that in addition to what he had previously stated was new over the prior art, was the process of simultaneously recording the sound and picture record, and in printing them side by side on different longitudinally extended portions of the same positive film, without regard to whether they are separately developed or not.

The original specifications were amended to state that the separate development step might be eliminated.

This amendment invalidated the two-step claims, as a separate development to overcome under and over exposure of the different picture scenes was the most important part of the disclosure, and by its elimination the invention claimed therein was different and broader than the one disclosed by the patentees in their application as filed.

It was old and well known in the art to have both the picture sequence and sound sequence printed side by side on a positive film, and also to put the sound record beside the picture record on a single film.

Walker patent No. 1,168,717 discloses that the picture negative and sound negative were put on different longitudinally extending portions of the positive film at different times.

Craig patent No. 1,260,337 discloses in the negative process recording of sound negatives and picture negatives on separate films, and the two negative films developed separately and printed on opposite sides of one film.

The patentees filed their first application for the alleged invention in Germany, on April 15, 1921, and thereafter within the convention period they filed their application in the United States on March 29, 1922, and their British application on April 11, 1922, all three being substantially identical including their claims. The original claim 1 was for the two-step process of developing and printing, specifying that the two records are developed separately, but not whether made on one or two films, and then printed on a single film. Claim 2 was limited to these two steps by reference back to claim 1, and added the third step of exposing or photographing the two records on separate films. Claim 3 was limited to the two steps of claim 1 and added two additional steps, namely, the photographing on a single film, and the subsequent di-

viding of that film for separate development. Claim 4 refers back to the several steps of each of the three preceding claims, and adds to the several steps of each, the step of reuniting the two negatives before printing.

The application of the patentees in each of the three countries was therefore for a patent for their separate film process.

Defendant offered in evidence the file-wrappers and contents of the German Patent Office, and the British Patent Office, but I can find no authority for their reception other than to show what was the application originally filed, and the patent that was granted.

The German patent issued to the patentees was published on February 2, 1923.

There was offered in evidence the German patent No. 279,598, of 1914, to Reimer, which specifically claimed:

> "Process for the making of a film which consists of an image band and a sound band having the distinctive feature that each band is made as an individual band separately and that both bands are thereupon combined with each other."

This appears to exhaust any novelty as a process in the patentees' separate film process.

Defendant also offered in evidence the British specification offered to public inspection by the British Patent Office on April 15, 1922, four days after it was filed. This was admissible to show the application that was filed.

Defendant also offered in evidence British patent No. 178,442, as printed and placed on sale at the British Patent Office on December 7, 1922.

Between April 15, 1922, the time of filing, and December 7, 1922, when the application was printed and placed on sale, the fourth paragraph of the specification was changed by substituting the following:

> "The process for the production of combined sound picture films hereinafter set forth differs from previous attempts in this direction, chiefly in the per-

fect synchronization of the sound and picture sequences, whilst permitting of the separate development of the respective negatives necessitated by unavoidable variations in the lighting of the films during the initial exposure.

"Attempts have been made to attain the end in view by taking the two negatives separately and independently and subsequently combining the records for reproduction; but it is found impossible to secure full synchronization in this manner.

"It has also been proposed to pass two separate films for the picture and sound records respectively, the film being driven positively and simultaneously by passing over the same sprocket wheel through a talking apparatus and to provide means for producing a series of corresponding identification marks upon the films by aid of which the two films after separate development can be reassembled; but this process also lacks the requisite accuracy of register.

"According to the present invention, the difficulty is overcome by employing films for the production of the negatives which are integral during the photographing, but which are separated from one another before developing.

"After development, these two negative films are reunited and are copied upon the same positive film. In this way, the absolute coincidence of the sound and the picture record respectively is assured, whilst the needful difference in treatment can be given during the development."

The patent was published with only one claim, as follows:

"Improved process for the production of combined sound and picture records, in which the sound record and the picture record are produced simultaneously on a single film which is then divided and the two parts developed separately, and afterwards reunited and used to print the single positive record."

This brings us to the United States application.

On April 14, 1922, the day before the British application was opened to the public, the United States Patent

Office Examiner acted on the application, and cited the Bullis patent No. 1,335,651.

On November 25, 1922, shortly before the revamped British patent was published, the patentees cancelled all the original claims of the United States application, and inserted a single claim which was identical with the single claim of the British patent, *supra*.

This action, it seems to me, must have been taken in view of the Bullis patent.

No drawing was filed with the original application, but by amendment a drawing was filed on November 25, 1922.

The defendant frequently referred to counsel's arguments and statements during the progress of the patent through the Patent Office, but these are not admissable to show estoppel, and therefore I have not considered them.

The new claims were specifically limited to the divided film process.

The actions of the patentees on their applications in Great Britain and the United States seem to me to be susceptible of only one interpretation, and that is, that they are intended to and did abandon the alleged invention covered by the claims in suit.

On April 19, 1923, after the British Patent was issued, the Examiner in the United States Patent Office rejected the single claim, stating:

> "The claim is rejected as not involving invention over Bullis of record. It does not involve invention to make the record on a single film instead of on two films rigidly attached together, especially in view of the fact that the single film is afterwards cut apart as the parts of the united film are taken apart."

The patentees by amendment acquiesced in the rejection and cancelled their single process claim without reservation of any kind, and inserted in the amendment two product claims, requiring in each claim one homogeneous film band, on which the sound records and picture records are copied, the first claim being for a com-

posite print produced from separate films, and the second claim for a composite print produced from a cut or divided single film.

The Examiner, on October 15, 1923, rejected claim 1 upon the prior Craig patent, No. 1,260,337, which he held "shows a film on which two separate negatives are copied". He further said, "Claims 1 and 2 are rejected as defining an article by the process of making it. In order that claims of this character may be allowed, it is necessary that the article have physical characteristics which an article made in the old way would not have. This is not true in this case."

The Examiner further said:

> "Claim 1 is required to be canceled. In response to the requirement for division contained in the Office Action of April 14, 1922, applicant elected the form in which the records were made on a single film and then cut apart. He can not now claim the species in which they are now made on 2 separate films."

No further action was taken for nearly a year.

In the interim plaintiff's present counsel were retained to prosecute the application which they continued during the remaining seven years.

They interviewed the Examiner and on September 29, 1924 filed an amendment containing two process claims the obvious purpose of which, it seems to me, was to recapture the process which had been abandoned.

On January 26, 1925 the Examiner rejected both claims, citing Greensfelder patent No. 1,254,684, and also the abandoned British specification No. 157,751, filed by the patentees of the patent in suit, and corresponding to French patent No. 532,750.

The applicants on April 2, 1925, by amendment added as claims 3 and 4, claims 1 and 3 of patent No. 1,489,314, to DeForest, which had issued a year before, and requested an interference.

On April 6, 1925, the Examiner again rejected the claims on their merits, and said:

> "Claims 1 and 2 are rejected on Craig, 1,260,337 in view of Greensfelder, 1,254,684, both of record. It is shown to be old in Craig to take separate synchronous sound and picture records simultaneously, and to then reproduce these two records on a single record strip. Applicant desires to reprint both records on one side only, but this is the teaching of Greensfelder, note page 3, line 128, to page 4, line 8."

The Examiner was the same Examiner who had granted the DeForest patent, and he further said:

> "Claims 3 and 4 are rejected as not based on the disclosure of applicant. Applicant takes a sound record and a picture record and reproduces these two records on a third film. These claims, however, call for a sound record and a picture record as does applicant, but the claims then define that the sound record is reproduced on the original picture record strip which is not the method of applicant. If however, it requires that a positive of the sound record be made and a reprint of this be taken on the original picture strip, still it would not be the method outlined by applicant in his specification. The steps are clearly not the same. Referring to the case of the patentee, the reference Craig cited in this action was held not to be a reference against the claims here under consideration, and though the steps in the method of applicant and of Craig are the same, yet the claims of patentee were held patentable over Craig. Therefore, it is evident that applicant cannot make the claims of the patentee as applicant does not disclose such a method in his application."

On April 23, 1925 the patentees filed another amendment.

On April 27, 1925 the Examiner allowed the divided claim, but finally rejected claim 1 and claims 3 and 4 of the two DeForest claims.

From this action an appeal was taken to the Examiners in Chief.

Under the rule of the Patent Office no question of patentability or invention could be considered in connection with the DeForest claims, because those claims were taken from an issued patent and the Examiners did not find a clear anticipation.

Having decided that the patentees could make the DeForest claims, the Examiners under the rule rendered a perfunctory decision as to the patentability of the other appealed claim which was more limited by specifying the separate development step, and said:

> "The Examiner allowed these claims, which is evidence of their patentability, notwithstanding that the Greensfelder patent was prior art, and which shows the printing of the two positives side by side, Fig. 5, as does also the Craig patent as above set forth. Greensfelder does not photograph his negative simultaneously. While the disclosure in these patents may tend toward a possibility of doubt as to invention being involved in the process defined by claim 1, the grant of the patent to DeForest and the lack of clear anticipation in either of the references or in their combination as to the addition or substitution of features in one not shown in the other and involving the question of invention vs. mechanical skill, we are of the opinion that claim 1 should be allowed in the absence of more pertinent and anticipatory art and appellants allowed to be placed in interference with DeForest to determine the question of priority."

The interference was decided on the merits in favor of the patentees by the Examiner of Interferences and also by the Board of Appeals, and an appeal was then taken to the Court of Customs and Patent Appeals, in which last named court, on the argument, counsel for DeForest in effect conceded priority to the patentees, and the decision of the Board of Appeals was affirmed.

I have not considered the arguments or briefs on the interference, as I am not satisfied that they are admissible.

The interference with the DeForest claims should not have been allowed. Those claims were for a different process than that disclosed by the patentees. This appears to me to have been conceded by plaintiff's counsel in his opening statement on this trial.

Those claims could never have dominated the patent in suit, for if so broadly construed they would not have been sustained over the Craig patent, No. 1,260,337, as the claims themselves read on the Craig patent, if the limitation to the additional rephotographing step is not given its intended meaning.

What DeForest taught and the meaning of the claims clearly appears from the specification of his patent, and that was, instead of printing his sound and picture records directly onto a positive film, as in the patent in suit, DeForest introduced the separate and distinct additional step, namely, a photographing or rephotographing of the sound record onto the original picture negative to obtain "a more exact and faithful photograph containing any details of the finest light variations produced by sound waves." DeForest preferred to make the original sound record larger in size than could be accommodated with the pictures on the positive film, and to reduce its size by the additional photographing step.

Except for the interference which was sought on behalf of the patentees and was not forced on them by DeForest, I am convinced that the patent in suit would not have been granted with the claims in suit, and it is worthy of note that the only claims in suit which state that the two records are printed on the same side or face of the film, a point on which plaintiff lays great stress, are claims 7, 8 and 9.

By the amendment of July 15, 1931, the alleged invention of the patent in suit was broadened to eliminate the separate development step, the most important part of the original disclosure, and to disclose the different two-step process of exposing and printing.

Claims 8 and 9 as I have hereinbefore pointed out are invalid, as they are for a different alleged invention than the original. Motion Picture Patents Co. *v.* Independent M. P. Co., 200 Fed. 411.

The only other two step claims in suit, 6 and 7, were by the Disclaimer limited to the third step of separate development.

Further, the two-step claims in suit and the broadening amendments were not inserted until July 15, 1931, and that was long after the process had gone into public use, and such an attempt should be regarded by the courts with disfavor. Railway Co. *v.* Sayles, 97 U. S. 554, 563.

Plaintiff contends that it made a two-step claim as early as July, 1925, which was when it found the DeForest patent, but even then it was new matter and was not accompanied by the broadening amendments to the specification inserted July 15, 1931.

The alleged invention of the claims in suit is a process and not an article or product.

A process consists of certain steps or operations in which the invention, if any, must reside. Cochrane *v.* Deener, 94 U. S. 780; Walker, 6th Edition, Sec. 19.

The patent in suit is entitled "Process for Producing Combined Sound and Picture Films". It is merely an example of composite or combination printing, a term applied to the making on a single piece of photographic sensitive material prints or impressions from two or more separate negatives, which is very old.

No photographic operation is involved which was not employed in the old art of composite printing which involved both simultaneous and consecutive exposure of separate negatives, separate development of those negatives in an appropriate manner and with different lengths of development, and both simultaneous and consecutive printing of the separate negatives on a single positive film: and was used in both black and white and color photography, and in both still and motion pictures, long before any date important here.

The patentees made no contribution to the art of photography.

Before 1900, sound was recorded photographically.

Photographic recording of sound with motion pictures and producing a combined sound and picture film, the same as the film in use today, is described in Haines British patent No. 18,057, of 1906.

The composite printing process of the patent in suit for sound pictures was adopted as the need arose and was used by Craig as early as 1913.

The Craig patent No. 1,260,337 discloses simultaneous recording of sound and pictures on separate films, which are developed separately and printed consecutively on the same positive film, and also shows in Fig. 8 a plurality of sound records printed side by side on the same side of his positive film.

I disagree with plaintiff and agree with defendant's expert Jones, that the Craig patent was operative.

The Craig patent as I view it, although this is now disputed by plaintiff, anticipates any invention in the process defined in the claims in suit. It is true that Craig printed his sound record on the opposite rather than on the same side of the single positive film, but printing sound and picture records on the same side of the film was well known in the art at that time, and Craig's specification shows that he contemplated printing the sound record on the same side of the film as the pictures, as he says therein:

> "It will be noted from what has gone before that so far the negative of the sound record and the negative of the picture record have been made upon separate strips or films. It is necessary, therefore, that these two negatives should be photographically printed upon one film or upon opposite sides thereof."

Even if the patent was silent on that point, the patentees cannot base their monopoly upon the printing of the sound and picture negatives on the same side of the

film, which was old and well known and was not even mentioned in the patentees' original specification.

What the patentees were concerned with was the separate development then required for different portions of the picture negative.

The Greensfelder patent No. 1,254,684 disclosed as I understand it, although this is now denied by the plaintiff, everything in the claims in suit but simultaneous recording.

It cannot be distinguished on the ground that it teaches nothing regarding the recording of acoustic vibrations. It discloses photographing of the sound in the sense of photographically producing a sound record, and a picture record, each on separate films, and then printing both on different portions of the same film.

Simultaneous recording of pictures and sounds was obvious and universal practice, and was disclosed in the Craig patent No. 1,260,337.

Separate development was old and well known in the art, and Craig and Greensfelder separately recorded records would of necessity be separately developed.

Again I disagree with the plaintiff, as it seems to me that the Bullis patent No. 1,335,651 disclosed everything in the claims in suit but printing the simultaneous and separately developed negatives on a single homogeneous film. His apparent preference was for producing his single positive film, by first printing from his negatives, and then joining them together.

This, however, does not seem to me to be sufficient to relieve the claims in suit from anticipation, as it was old in the art to print on the same film simultaneously and separately developed negatives.

No reason has been shown nor have I found any why it is impossible for the Bullis patent and the Craig patent No. 1,260,337 to be combined together to anticipate the claims in suit; therefore I disagree with plaintiff's contention that they cannot be so combined together.

The Bullis construction is not impractical.

The Bullis patent was cited by the Examiner early in the prosecution of the patent in suit and, as it seems to me, resulted in the cancellation of the original claims.

From that time on, however, it was undoubtedly lost sight of, and was not called to the attention of the Examiners in Chief, and while as plaintiff contends it may have been in the file, yet no reference was made to it by them, and as I consider it a most pertinent reference, it seems to me that the failure to cite it against the claims as finally allowed deprives the patent in suit of the presumption of validity over the prior art.

Walker patent No. 1,186,717, which is for a combined camera and recorded, was not cited in the Patent Office in the prosecution of the patent in suit, but was a pertinent reference. It discloses the consecutive printing of sound and pictures on the same side of a single positive film of standard width, and I agree with the expert Jones, there "is no functional difference between printing consecutively the picture record and the sound record on the single positive film, as disclosed in this Walker patent, and printing consecutively the separate sound and picture records on a single positive film as disclosed in the patent in suit."

Walker's film is of standard width; the patentees' film is non-standard.

Walker's film, I believe, could be produced by using the separate negatives of Craig and Bullis, in Walker's printer.

It was everyday practice in the motion picture industry, as early as 1908, to print on standard positive film composite pictures from separately developed negatives.

See testimony of Nonnenbacher, and Messter patent No. 1,286,383; British patent to Rossi, No. 21,467 A. D. 1902; and British patent to Downing, No. 6,727 A. D. 1913.

Each of these patentees made their records on separate films, developed them separately, and printed a plurality

of records on the same side of the positive of a moving picture film. The process of the patent in suit is not changed from the process of those patents, as it matters not whether the records printed on the same side of the film be sound and pictures, or a plurality of pictures, as the process steps are identical. Brown *v.* Piper, 91 U. S. 37; Penn. Railroad *v.* Locomotive Truck Co., 110 U. S. 490; Dreyfus *v.* Searle, 124 U. S. 60.

It seems clear to me that in combining the old elements of the claims in suit there was no invention by the patentees, but merely a judicious selection from the prior art. Newcomb *v.* McMahon, 59 Fed. (2d) 899.

It is not necessary that all of the elements of an alleged invention be found in one patent. Zimmerman *v.* Advance Machinery Co., 232 Fed. 866, 869, 870; Dilg *v.* George Borgfeldt & Co., 189 Fed. 588, 590; Keene *v.* New Idea Spreader Co., 231 Fed. 701, 708; Linville *v.* Milberger, 34 Fed. (2d) 386, 388; Reflectolyte Co. *v.* Luminous Co., 20 Fed. (2d) 607, 611.

The question is not whether the claims in suit are anticipated by any one patent, but whether there is any invention over the prior art, and I am unable to find any such invention.

The three following described patents relate to sound pictures *per se*.

British patent to Pederson, No. 115,942 A. D. 1918, discloses the recording simultaneously of sound and pictures photographically on a single film. After suitable treatment, the sound negative is separately impressed on the single positive film by embossing, which is a printing operation but not photographic printing, on which the pictures are printed from the original negative.

Kinderman British patent No. 18,163, of 1913, discloses the attaching to the picture negative of a separate wax-coated strip on which he recorded his sound, simultaneously with his pictures, by means of a stylus.

Reimer German patent No. 279,598, of 1914, discloses the recording of sound and pictures simultaneously on

separate bands, the picture negative being separately developed, and the sound record separately treated by the well known galvanic process. A copy of the sound record is then made and attached to the separately printed picture positive, forming a single combined sound and picture film.

As to the disclaimer filed herein, after plaintiff had been furnished with a statement showing that both of defendant's films receive the same character of development, it seems to me to be for a purpose that the statute was never designed to permit. Fruehauf Co. *v.*, Highway Co., 54 Fed. (2d) 691.

Even with the Disclaimer, claims 6 and 7 show no invention over the prior art.

The claims in suit show no invention over the prior art.

Plaintiff recites at length what it contends are the advantages of the alleged invention, but it seems to me that it does not point to any advantage which does not apply to the prior art which I have considered, and some of the advantages recited by plaintiff are not mentioned in the patent in suit.

The cases cited by plaintiff to show validity do not seem to me to be in point.

No commercial success is shown by the plaintiff, and the patentees made no real contribution to the art. The success of the defendant, its licensor and its licensees is due to the many inventions of the Western Electric Company, without which success would have been impossible.

The claims in suit of the patent in suit are invalid by reason of anticipation and lack of invention over the prior art.

The patent in suit is further attacked as invalid under Section 4887 of the Revised Statutes, Title 35, Sec. 32 U. S. Code, so much of which as is necessary for consideration herein providing as follows:

> "No person otherwise entitled thereto shall be debarred from receiving a patent for his invention

> or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and four months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country."

Patentees' French patent No. 532,750 was granted November 21, 1921, on an application filed March 25, 1921. This application was filed more than one year before March 29, 1922, the filing date in this country of the patent in suit. The French patent was granted long before the patent in suit.

The prosecution of the application filed in this country April 4, 1921 was abandoned by the applicant.

It seems clear to me, although it is sharply contested by plaintiff, that the French patent is for the same alleged invention as the patent in suit, as it discloses simultaneous recording of sound and picture records on separate films, which by reason of being separate are necessarily separately developed, and printing of the separate negatives on the same positive film.

While it is true that what is known as "scoring", in which the sound is recorded after the pictures are taken and while they are being projected, is also disclosed in the French patent, that does not change my opinion hereinbefore stated, that the patent in suit is for the same alleged invention, and that is the question to be determined. General Electric Co. *v.* Alexander, 280 Fed. 852, 854.

Plaintiff's contention that this defendant failed to prove what invention was patented under the laws of France, in the said French patent, is not sustained.

The French patent is in evidence and speaks for itself, and both describes and claims the alleged invention of the patent in suit.

The courts in dealing with this statute have always looked to the claims of the foreign patents and read them in the light of the disclosure and decided what is patented, the same as they do with the domestic patents. Merrell-Soule Co. *v.* Powdered Milk Co., 222 Fed. 911, 913; Sirocco Co. *v.* Sturtevant Co., 220 Fed. 137, 143; Commercial Acetylene Co. *v.* Searchlight Gas Co., 188 Fed. 85; Siemens *v.* Sellers, 123 U. S. 276, 282; Leeds & Catlin *v.* Victor Co., 213 U. S. 301, 321; Fireball Gas Co. *v.* Commercial Acetylene Co., 239 U. S. 156, 165.

See also Western Electric Co. *v.* Citizens' Tel. Co., 106 Fed. 215, at page 217, where it is expressly stated that the laws of the foreign countries were not proved, but the court held that the foreign patent, an Italian patent having no formal claims, was for the same invention.

The French patent undoubtedly claims the process of claims 6, 8 and 9 of the patent in suit, and I can find no support for plaintiff's contention that the French claims do not touch upon separate development which is specified in claims 5, 7 (by Disclaimer) and 11 in suit.

Separately recorded records are described and expressly claimed in the French patent, and the evidence clearly shows that separately recorded records are necessarily separately developed.

Plaintiff's attempt to distinguish between claims 7 and 9 of the patent in suit and the French claims, on the alleged grounds that the latter do not touch upon the matter of consecutive printing, and that the French claims do not state that the films are separate at the time of development (as stated in Disclaimer, Amendment 6) utterly fails.

Neither is a matter of substance nor constitutes the essence of the alleged invention.

That the films are separate at the time of development is obvious, and claim 5 of the French patent clearly states that the two records are copied on the same film, and it is of no moment whether both records are printed at once, or one after the other.

What is required to constitute identity of a patent within the purview of Section 4887 is substantial not formal identity of invention, as covered by the claims. United Shoe Machinery Co. *v.* Duplessis Co., 148 Fed. 31, 34, 35.

The abandonment of the application based on the French patent, which was for the same alleged invention as that of the patent in suit, made it impossible for the patentees to obtain a United States patent on an application, filed more than one year after the French application, for the alleged invention of the patent. Robert Esnault-Pelterie *v.* Chance Vought Corporation, C. C. A., Second Circuit, July 17, 1933.

The patent in suit is invalid under Section 4887 R. S., Title 35, Sec. 32, U. S. Code, unless plaintiff can maintain its contention that the application for the patent in suit is a continuing application, and entitled to the dates of the abandoned application.

In order to accord to the patent in suit the date of the abandoned application, intent to continue the earlier abandoned application by means of the application for the patent in suit must be shown.

On the face of the application for the patent in suit, it was entirely independent of and hostile to the abandoned application, and nowhere in the prosecution of the application for the patent in suit is there any suggestion of the intent to continue.

Further, it seems to me that in the prosecution of the application for the patent in suit, the intent to continue was not merely absent, but that the evidence shows an intent not to continue.

As late as April, 1931, in the brief filed on behalf of the patentees in the interference with DeForest, it was

stated that the earliest date to which they could carry back the date of application for the patent in suit was "limited to April 14, 1921", the date of the German application corresponding to the patent in suit.

The preliminary statement of patentees in said interference states:

> "The invention was introduced into the United States by the application papers, viz., the present application Ser. No. 547,860, which papers were received in the United States on or about the 24th day of March, 1922."

It contains no reference to the application for the French patent on which plaintiff now seeks to rely, or to any other foreign application corresponding to the abandoned United States application.

The oath to the application for the patent in suit contains no reference to the application for the said French patent or other corresponding foreign application, as required by the rules of the Patent Office.

On January 26, 1925 the Examiner rejected the patentees' claims on the patentees' own British application, No. 157,751, corresponding to the abandoned United States application and the said French patent.

No attempt was made by the patentees to carry back their date to that of the abandoned application, but they contended that the British complete specification was not accepted and the application had become void, and that although a publication, it was not available as a reference, as it was not a printed publication more than two years prior to the then pending application.

No mention was made of the French application which had enured into a patent some years before.

It seems clearly established that the patentees did not intend to continue the abandoned application but to prosecute the application for the patent in suit as an independent and hostile application. American Casting Mach. Co. *v.* Pittsburgh Coal Washer Co., 237 Fed. 590.

That the Scott's abandoned application described in the case last cited was a joint application does not change the situation, as a joint application could while pending have been amended to make it a sole application or a new joint application filed while preserving the benefit of the date of the original application. Union Switch & Signal Co. *v.* Kodel, 55 Fed. (2d) 173; *In re* Roberts, 263 Fed. 646; Bijur *v.* Kennington, 278 Fed. 313; and Briggs v. Kaisling, 288 Fed. 254.

The following cases cited by plaintiff are not in point, as in each case a clear intention to continue was expressed while the application was pending. Smith *v.* Goodyear Co., 93 U. S. 486; Corrington *v.* Westinghouse, 178 Fed. 711; Novadel Corp. *v.* J. P. Meyer & Co., 35 Fed. (2d) 697.

Plaintiff is debarred from claiming, as it did for the first time on the final hearing of this suit, that the application for the patent in suit is a continuing application, and entitled to the date of its abandoned application.

The patent is invalid.

A decree may be entered in favor of the defendant against the plaintiff dismissing the bill of complaint on the merits, with costs.

Settle decree on notice.

Submit proposed findings of fact and conclusions of law in accordance with this opinion for the assistance of the court, as provided by Rule 70 ½ of the Equity Rules and Rule 11 of the Equity Rules of this court.

U. S. D. J.

The Opinion of the Court of Appeals, Reported in 71 F. (2d) 153.

UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE SECOND CIRCUIT.

AMERICAN TRI-ERGON CORPORATION,
Plaintiff-Appellant,

AGAINST

PARAMOUNT PUBLIX CORPORATION,
Defendant-Appellee.

Before:

MANTON, SWAN and CHASE,
Circuit Judges.

Appeal from the District Court for the Eastern District of New York. Suit for infringement of patent; decree for defendant; plaintiff appeals. Reversed.

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MANTON, *Circuit Judge.*

This suit is for infringement of patent No. 1,825,598, a process for producing combined sound and picture films.

It is called sound on film. The application for the patent was filed March 29, 1922, and granted September 29, 1931, after a long interference proceeding with DeForest patent No. 1,489,314 which was finally decided by the Court of Customs and Patent Appeals in appellant's favor. Prompt prosecution for this infringement followed.

Appellee is a producer of talking motion pictures and practices this process of producing sound on film motion pictures as taught by the patent in suit. The Western Electric Co., and its wholly owned subsidiary, Electric Research Products Inc., licensed its licensees, including the appellee, to use the process as the "Western Electric Sound System".

A German application for the same process was filed April 14, 1921.

The problem sought to be solved by the patent was bringing together on one positive film the picture record, which requires one type of development, and a sound record which requires a different type of development. Its accomplishment marked an important advance in the art. Makers of talking motion pictures, including the Western Electric Co. and its associates, during the period following the application for this patent tried, but until the inventors exhibited this process, accomplished little with the development of sound on film. While all apparatus necessary to practice the present invention was at hand and owned by the Western Electric Co. and its affiliates, no one solved the film problem presented by the requirement of different treatment for sound and picture records. The difference in treatment was necessary to avoid distortions of one or the other or both in reproduction. The engineers of the Western Electric Co., in this period, struggling for the solution of the problem of sound on film development, turned to sound on disc. The first successful talking motion picture in this country was produced by sound on disc. The process of the patent in suit was brought to this country

from Germany. Western Electric Co.'s engineers examined and tested it. They thereupon used it and it superseded sound on disc. Its adoption has become universal and speaks for the merit of the inventive thought therein involved. No sound on film was made as this record discloses until the appellant's process appeared. Prior patents proposed using sound on film in connection with motion pictures. One was the single film system which involved recording sound and pictures simultaneously on the same negative film, developing that film as a unit, and then printing the sound and picture records from the single negative film onto a single positive film. This involved no separate development of the sound and picture sequences on a negative film, and was unacceptable for talking pictures of good quality. Pictures require one type of development while sound requires another. No single developing treatment is appropriate to both. Simultaneous development in a single developer produces poor pictures or poor sound or both. The resulting inferior product has relegated the system to uses where sound is not of importance. The other system, the double film system, records sound and pictures simultaneously on separate films. Here the picture negative is developed and printed on one positive film and the sound negative is separately developed and separately printed on another positive film. This system in practice requires two separate projectors, one for the picture positive and the other for the sound positive. This necessitates the use and synchronization of a double set of projectors, which makes it impossible to commercialize the double film system. Prior patents suggested employing a double film system and endeavored to bind the two separate films on a single projector. But this was cumbersome and impracticable. The double film system did not permit the use of a single or unitary positive print and failed to solve the problem.

By the invention in suit, a product of a single positive film bearing the sound and picture records side by side

is produced. The new process permits both the sound record and the picture record on the positive film to be as perfect as the arts of photography and telephony can make them and neither is compromised in quality by reason of the presence of the other, as was the case in single film systems. The result is accomplished by recording the sound and pictures on separate films; then separately developing the sound and picture films in separate developer solutions under development conditions appropriate to the requirements of each. A single positive print is made from these two separately developed negatives, by printing the sound and picture sequences side by side on the same face of the positive film. While it might be said that superficially the positives so produced are similar to the positives produced by the single film system, still the function and effect is different and in the practical art that difference has been demonstrated. Combining steps of the double film system and steps of the single film system, the inventors have made a combination, and a process for achieving a new result which has been effective and enduring and has become the standard practice in the industry.

The practical importance and achievement of the invention lies in its product—a one piece positive film having side by side in fixed synchronism on one face picture sequences and sound sequences, each having been recorded simultaneously on separate negatives and developed separately according to its own requirements.

The claims sued upon are 5, 6, 7, 8, 9 and 11. Claims 6 and 7 are to be read with the disclaimer filed. Claim 5 is typical and reads:

> "5. A process for producing a combined sound and picture positive film, for talking moving pictures, comprising, photographing a sequence of pictures on one length of film, and simultaneously photographing on another length of film a corresponding sequence of sounds accompanying the action, separately developing the two negatives in a manner appropriate for

> each, and printing the sound and picture negatives respectively upon different longitudinally extending portions of the same sensitized film, to form the sound sequence at one side of and along the picture sequence."

The commercial use of the patented process is fullsome testimony of its inventive worth. The result of testing it by the inquiry, as it should be, of what has been the commercial success of the invention rather than the appellant's commercial success, adds greatly to its validity.

In addition to the German patent for the same process, a British application for the same process was filed April 11, 1922. It was identical with the United States and German application. The British application resulted in a patent as did the German. The Western Electric Co. scientist, Dr. Wente, applied for a patent disclosing and claiming the invention of the patent in suit. The application stated that for correct sound reproduction

> "it is important that the development of the positive and negative be so carried out that the transmission of the positive is at every point proportional to the exposure of the negative. This is in general not the best condition for the pictures as under these circumstances they will usually be too harsh. In the system here proposed the picture negative and positive can be developed to give the most pleasing results for pictures, and yet the negative of the sound record can be so developed that when it is printed on the picture positive film the required contrast is obtained in the positive sound record."

His claim No. 31 was rejected on the patent of these inventors' (British Patent No. 178,442) corresponding to the patent in suit and was cancelled. And after that experience, it is now argued, by the Western Electric Co. which is defending this suit, that there is no validity. That Company is hardly in a position to question validity of the patent. DuBois *v.* Kirk, 158 U. S. 58; General

Knit Fabric Co. *v.* Steber Machine Co., 194 Fed. 99 (C. C. A. 2); Sugar Apparatus *v.* Yaryan, 43 Fed. 140, 144.

The patents of the prior art to which reference is made, are fairly stated to be but paper patents and they do not anticipate. Composite printing of photographs is illustrated in the Bandman patent No. 125,522 and Jenkins patent No. 606,993. An apparatus for printing motion picture films with pictures arranged alternately in two adjacent series are shown in Dyer No. 970,614. The Haines British patent of 1906, No. 18,057, is an example of single film system. It is clear, however, from the description, that both the picture series and the sound track were to be recorded on the same negative film. The Rossi British patent of 1909, No. 21,467, had the idea of saving expense in positive prints by printing the picture series from one picture negative on one half of the positive and another picture series of another picture negative on the other half of the positive print along side the first series. The inventor made no suggestion of the combination of the two systems, nor does he disclose any process whereby the single positive film may be produced with sound and picture sequences after separate development of each appropriate to their respective requirements. Craig No. 1,260,337; Bullis No. 1,335,651 and Greensfelder No. 1,254,684 were before the patent office and there held not to be anticipations. Craig did not show or describe anywhere a sound and picture record on a single film where the sound and picture records did not overlie each other. In the process he was attempting to operate, he wanted to print on opposite sides. The experts agree that this is wholly inoperative. His patent was owned by a well known corporation—the Eastman Kodak Co.—with resources for investigation and practical uses, but apparently it was found of little value. Greensfelder proposed carrying out his purpose by providing a space for different sound marks adjacent to each film of the picture

sequence. The location of the sound mark in the space controlled the noise to be produced. Each location was to be connected by a separate selenium cell and train of mechanism, with the noise machine corresponding to that location. Thus, if a sound mark were recorded on the extreme left of the space it might effect the beat of a drum; if it were in a different location it might blow a whistle. The invention in suit has a photographic picture of sound waves on the sound track. Greensfelder had only an arbitrary arrangement of sound marks each identical with the other and differing only in its location in the space reserved for the sound marks. Greensfelder takes his picture negative, develops and prints it first before trying to make sound marks at all. The latter are to be on a separate film after the picture positive has been completed and reproduced as a silent movie. In no event does the development of Greensfelder's sound mark negative present any problem like that in the independent development of the sound and picture negatives. Greensfelder does not provide for separate development of picture and sound negatives. He has no sound negatives, and as a practical matter the patent is addressed to a method to escape from problems of photographic recording of the natural sounds accompanying the action. It does not deal with the "talkies" problem. The Walker patent No. 1,186,717 was limited to an old single film system; the sound and pictures were to be taken simultaneously on a single negative developed together and printed together. There is no disclosure of the separate development of the sound and picture negatives in the manner appropriate for each, and their subsequent printing on the same positive film. All the disadvantages that are inherent in the single film system with its identical development of both the sound and picture sequences, are present in Walker's disclosure, and he makes no suggestion which would aid in avoiding them. Other patents of the prior art are far afield from any anticipation of the patent in suit.

A defense of abandonment is interposed under Revised Statutes §4920. It must be affirmatively pleaded in the answer, and this was not done. The claim of abandonment imposes a heavy burden upon one asserting it.

On April 14, 1922, the examiner rejected the claims citing Bullis patent No. 1,335,651. On November 25, 1922, the applicants cancelled their original claims from the United States application and inserted a single claim addressed to the divisible negative film feature which was the subject matter of original claim 3. On December 7, 1922 the corresponding British patent issued with but a single claim identical with the divisible film claim then standing in the United States application. On September 29, 1924 before any use of the invention in this country, claims corresponding in scope to claims 5, 6, 7 and 11 were asserted in the United States application. After March 31, 1925, claims corresponding in scope to claims 8 and 9 in suit were asserted in the application. There were no intervening rights of any sort established by the appellee or by the public in the interval between November 25, 1922 and March 31, 1925, nor was there any unreasonable delay on the part of the applicants in reasserting their invention in the broad scope justified by the original disclosure. Throughout the entire period, the applicants were asserting the invention in its broad scope in their German application and patent. That application was never restricted to the divided film system but was maintained in language broad enough to cover either the separate film system of the claims in suit or the divided film system illustrated in the United States patent. If the applicants to any degree acquiesced in the limitations in the British patent, the evidence is ample of their insistence on the invention in its broad scope in the German application. It is a common practice to vary the scope of the claims during the course of a patent application. To temporarily cancel the broad claims and later reassert them is permissible. In the

absences of intervening rights such claims are entirely proper. There is no requirement that the applicant shall in all cases from the date of application to the date of issue assert claims as broad in scope as those ultimately allowed. Wirebounds Patents Co. *et al. v.* Saranac Automobile Machine Corp., 37 Fed. (2) 880 (C. C. A. 6); Auto Pneumatic Action Co. *v.* Kindler & Collins, 247 Fed. 323 (C. C. A. 2). This defense may not be sustained.

The interference between the application in suit and DeForest Patent No. 1,489,314 was won by the patentees in the tribunals of the Patent Office and the Court of Customs & Patent Appeals. The DeForest invention subsequent to the invention of the patent in this suit.

The appellee argues that the patent in suit is invalid under the provisions of Revised Statutes § 4887 because of the issuance of a French patent No. 532,750, twelve months before filing the application of the patent in suit. To constitute invalidity of the present patent by the French application, it must be shown that the inventions actually claimed in that foreign country and those of the patent in suit are identical. It is not enough to say that the French patent may disclose the invention of the later United States patent, when it is not therein claimed. Leeds & Catlin *v.* Victor Talking Machine Co., 213 U. S. 301; General Electric Co. *v.* Alexander, 280 Fed. 852 (C. C. A. 2). The question becomes one of identity between them. There is no such identity here. The French patent is for a photo-phonetic film, namely, an apparatus or product claim, which cannot be identical with or fatal to a process claim. Leeds & Catlin *v.* Victor Talking Machine Co., *supra;* Fireball Gas Tank & Illuminating Co. *v.* Commercial Acetylene Co., 239 U. S. 156. The French patent is essentially a proposal for escaping from the difficulties of recording natural sounds accompanying the action. The significance of the independent recording of concomitant sounds is apparent from the language of the specification. Nowhere in the French

claims or specification is there a suggestion of the characteristic feature of separate and independent development of the negatives to compensate for different exposure in recording. The purpose of the French patent was to avoid the photographing of sounds "from sources which are scenic". Here the purpose is just the opposite. The distortions of sound and pictures which apparently had been unavoidable in single film practice and which had made scoring preferable have now been removed. The French patent in no way treats of separate development.

The patentees fully complied with Revised Statutes §4887 as to the French patent by filing an application substantially identical therewith in the Patent Office of the United States on April 4, 1921, ten days after the filing of the French application. While the application was pending in the United States, they filed a German application for the invention here in suit, and within the allowed period, thereafter filed the United States application for the patent in suit. The two United States applications were thus co-pending, and while the patentees have been insistent and consistent in their position that the inventions covered by the successive patents were not the same, still, if the inventions were the same, the first United States patent was filed within the convention period and their second application, being copending, is true continuation of the first. Novadel Process Corp. *v.* J. P. Meyer & Co., 35 Fed. (2) 697 (C. C. A. 2); Victor Talking Machine Co. *v.* American Graphaphone Corp., 145 Fed. 350 (C. C. A. 2).

The appellee's process infringes the claims in suit. The stipulation provides that the appellee's process for producing a combined sound and picture positive film for talking motion pictures comprises recording photographically a sequence of pictures on one length of film and simultaneously recording photographically a series of sounds accompanying the scenes on a separate film. The picture negative and sound negative are developed separately and

in different developers. The choice of developers and the time of development being such as to give the desired result. The picture and sound negatives thus separately made and separately developed are printed successively in properly spaced relation on the same surface of a positive film. In this manner a single positive film carrying the sound sequences and picture sequences is produced. There is no material difference between the purpose for which the appellee uses the process and that described in the patent. In any case, the appellee uses the process of the patent and achieves the results intended by the patentees. The patent is valid and infringed.

Decree reversed.

SWAN, *J.* Dissenting.